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PATENT APPLICATION

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of

Docket No: Q77281

Tadashi YONEDA

Appln. No.: 10/568,944

Group Art Unit: 3715

Confirmation No.: 8590

Examiner: Unknown

Filed: February 22, 2006

For: COSMETICS

SUBMISSION OF COMMUNICATION FROM EUROPEAN PATENT OFFICE

MAIL STOP AMENDMENT

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

Sir:

Applicant submits herewith for the Examiner's use an official communication (examination report) dated March 7, 2007, that was issued in the corresponding European patent application. Applicant notes that the document cited in the official communication (D1: WO 99/62482) was previously cited in an Information Disclosure Statement filed February 22, 2006, in the present application, and therefore is not being submitted again.

Respectfully submitted,

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23373

CUSTOMER NUMBER

Date: March 23, 2007



The examination is being carried out on the following application documents:

Description, Pages

1-31 as originally filed

Claims, Numbers

1-7 received on 20.09.2006 with letter of 20.09.2006

1. Prior Art

The following document is referred to in this communication:

D1 : WO 99/62482 A (ITO SHINOBU ; TSUZUKI TOSHI (JP); FURUYA KAZUO (JP); MASATSUJI EIKO (J) 9 December 1999 (1999-12-09)

2. Article 123(2) EPC

The newly filed claims are considered to be allowable. Basis for the expression cleansing cosmetics can be found on page 1, line 18 of the present application. The applicant is therefore requested to bring the description into conformity with these claims; care should be taken during revision, especially of the introductory portion including any statements of problem or advantages, not to add subject-matter which extends beyond the content of the application as originally filed (Article 123(2) EPC).

3. Novelty

As already has been mentioned, the present application meets the requirements of Article 52(1) EPC, because the subject-matter of claims 1-7 is new in the sense of Article 54(1) and (2) EPC.



4. Inventive step

The examining division has read carefully the arguments of the applicant regarding inventive step.

It is of the opinion that the present application does not meet the criteria of Article 52(1) because the subject-matter of claims 1-7 does not involve an inventive step in the sense of Article 56 EPC.

This belief is based on the following points: The structure of one of the claimed compounds, as already mentioned, is almost identical to the compound mentioned in D1. The only difference is that the sorbit (also called sorbitol), part of the compound claimed in the present application is the open form of the sorbitan which is part of the compound mentioned in D1. The other two parts of the claimed compound and the compound mentioned in the example 26 of D1 are identical (polyoxyethylene and fatty acid ester).

Therefore the difference of the two compounds is a minor one and because of that they are expected to have almost identical properties. The skilled person, having read D1, would, without the exercise of inventive step, try compounds such as those of the present application in his effort to improve the cleansing properties of cosmetic products.

Furthermore, contrary to the applicant, the examining division believes that D1 does anticipate the use of a cosmetic composition such as the one mentioned in example 26 of D1 as a cleansing agent.

Any composition having a surfactant uses a surfactant for two purposes: either to solubilize the material in the solvent system or to clean the surface where it is applied or both. Excluding one of the two effects and saying that the surfactant is used only as a solubilizer is not done in D1. On the contrary, claim 4 of D1 mentions the surfactant of the present application for use in external preparations for skin which means that the cleansing effect is obvious for any person.

Furthermore, there is no indication in the example 26 of D1 that the milky lotion is only to be used as moisturizing lotion and that it has no cleansing effect. Additionally, on page 14, lines 12-22, D1 teaches us that the compositions of D1 can be used as cleansing cream, shampoo, body shop etc. Also compounds such as the glyceryl derivative of claim 1 is disclosed in D1 (see page 21, lines 1-5).

Conclusively, taking into account the teachings of D1 and although it is not explicitly mentioned in example 26 of D1, the examining division believes that the presence of a surfactant system ensures some cleansing effect of compositions such as the one in



example 26 and that claim 1 is not inventive (Article 56 EPC).

Therefore, as already mentioned, the subject matter of the present application can only be regarded as inventive, if the compounds of the present application present unexpected effects or properties in relation to the rest of the range and more particularly, to the chemically closest compound such as the one of example 26. However, no such effects or properties are indicated in the application.

The reasoning of claim 1 applies, mutatis mutandis, to the subject-matter of the corresponding independent claim 7 which therefore is also considered not inventive.

Dependent claims 2-6 do not contain any features which, in combination with the features of any claim to which they refer, meet the requirements of the EPC in respect of inventive step (Article 52 (1) and 56 EPC).

5. Comments

When filing amended claims the applicant should at the same time bring the description into conformity with the amended claims. Care should be taken during revision, especially of the introductory portion and any statements of problem or advantage, not to add subject-matter which extends beyond the content of the application as originally filed (Article 123(2) EPC).